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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/875,864  | 06/07/2001  | Dwip N. Banerjee     | AUS920010357US1     | 9370             |
| 7590  | 09/01/2004  |                      | EXAMINER            |                  |
| Marilyn Smith Dawkins<br>International Business Machines Corporation<br>Intellectual Property Law Dept., Internal Zip 4054<br>11400 Burnet Road<br>Austin, TX 78758 |             |                      | ROSEN, NICHOLAS D   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |
| DATE MAILED: 09/01/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/875,864             | BANERJEE ET AL      |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Nicholas D. Rosen      | 3625                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 10 September 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-43, 45-53 and 55-61 is/are rejected.
- 7) Claim(s) 44 and 54 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 September 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

Claims 1-61 have been examined.

### ***Specification***

The disclosure is objected to because of the following informalities: In the twelfth line of page 88 (the Abstract), “feasiblely” should be “feasibly”.

Appropriate correction is required.

### ***Claim Objections***

Claims 22-32 are objected to because of the following informalities: Claim 22 could be interpreted as reciting a computer program per se, which is not patentable. Claim 22 recites a computer usable medium having computer readable program code means, but it is not clear what “means” means, and on a literal reading of the claim language, the claim could read on a program for procuring a manufacturer if that program resides on a computer-readable medium, and the medium has *other* computer readable program code means, even if the “program for procuring a manufacturer” is a list of instructions and recommendations for a human being to carry out. Furthermore, the program is described as comprising “means for”, which reads more like computer hardware. Appropriate correction is required.

Examiner suggests putting the claims in the format: “A computer program for procuring a manufacturer, said program embodied in a computer-readable medium, said program comprising computer-executable instructions which cause a computer to

perform: the step of transmitting . . .; the step of receiving . . .; and the step of enabling a response. . .”.

Claims 52-61 are objected to on essentially the same grounds as claims 22-32.

Claims 39, 48, and 58 are objected to because of the following informalities: In each of these claims, “said feasibility responses . . . for said adjusted project” lacks antecedent basis. Appropriate correction is required.

Claims 42, 51, and 61 are objected to because of the following informalities: In each of these claims, “said preferred manufacturer” lacks antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a method not within the technological arts (“technological arts” being considered equivalent to “useful arts,” mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have “power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries” – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract

idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). Procuring a manufacturer for a project request may be useful, but is not concrete or tangible.

Regarding claim 2, claim 2 recites use of a client connected through a network to a broker server system, but this is held to be a trivial use of technology, insufficient to toll the statute.

Claims 33-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a method not within the technological arts (“technological arts” being considered equivalent to “useful arts,” mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have “power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries” – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). Procuring a manufacturer for a project request may be useful, but is not concrete or tangible.

Regarding claim 34, claim 34 recites use of a broker server connected through a network to a plurality of client systems, but this is held to be a trivial use of technology, insufficient to toll the statute.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, and 6**

Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillman (U.S. Patent Application Publication 2002/0147674). As per claim 1, Gillman discloses a method for procuring a manufacturer for a project request, comprising the steps of: submitting a specialized project request for a buyer to at least one manufacturer broker (paragraphs 26, 27, and 30); receiving a plurality of feasibility responses for manufacture of said project request from a plurality of prospective manufacturers via said at least one manufacturer broker (paragraphs 38, 41, 42, and 44); and responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers utilizing a single project request (paragraphs 45, 46, and 49).

As per claim 2, Gillman discloses submitting said specialized project request from a client communicatively connected through a network to a broker server system (Figure 1; paragraphs 23-27).

As per claim 6, Gillman discloses receiving a bid to manufacture said project request from a selection of said plurality of prospective manufacturers (paragraphs 38, 41, 42, and 44).

### **Claims 12 and 16**

Claims 12 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillman (U.S. Patent Application Publication 2002/0147674). As per claim 12, Gillman discloses a system for procuring a manufacturer for a project request, comprising: a client computer system communicatively connected to a network (Figure 1; paragraphs 23-27); means for submitting a specialized project request for a buyer from said client computer system to at least one manufacturer broker via said network (paragraphs 26, 27, and 30); means for receiving a plurality of feasibility responses as compiled said at least one manufacturer broker for manufacture of said project request from a plurality of prospective manufacturers via said network (paragraphs 38, 41, 42, and 44); and means for responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers (paragraphs 45, 46, and 49).

As per claim 16, Gillman discloses means for receiving a bid to manufacture said project request from a selection of said plurality of prospective manufacturers (paragraphs 38, 41, 42, and 44).

**Claims 33, 34, 36, 40, and 41**

Claims 33, 34, 36, 40, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillman (U.S. Patent Application Publication 2002/0147674). As per claim 33, Gillman discloses a method for brokering project requests among a plurality of available manufacturers, said method comprising the steps of: receiving a project request from a buyer (Abstract; paragraphs 26, 27, and 30); distributing said project request according to type of manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers (paragraphs 34 and 35); and, in response to receiving feasibility responses from said selection of prospective manufacturers (paragraphs 38, 41, 42, and 44), facilitating feasibility of manufacture of said project request according to said plurality of feasibility responses, such that said project request is brokered for said buyer to facilitate obtaining a manufacturer for said project request (Abstract; paragraphs 45, 46, 48, and 49).

As per claim 34, Gillman further discloses receiving said project request at and distributing said project request from a broker server communicatively connected through a network to a plurality of client systems and a plurality of manufacturer systems (Figure 1; paragraphs 23-27).

As per claim 36, Gillman discloses transferring said plurality of feasibility responses received from said selection of prospective manufacturers to said buyer (paragraphs 36 and 42).

As per claim 40, Gillman discloses controlling access of said plurality of available manufacturers to said plurality of feasibility responses (paragraph 47).

As per claim 41, Gillman discloses transferring said project request to specific manufacturers designated by said buyer with said project request (paragraph 35).

**Claims 43, 45, 49, 50**

Claims 43, 45, 49, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillman (U.S. Patent Application Publication 2002/0147674). As per claim 43, Gillman discloses a system for procuring a manufacturer for a project request, comprising: a broker server system communicatively connected to a network (Figure 1; paragraphs 23-27); means for receiving a project request at said broker server system from a buyer (Abstract; paragraphs 26, 27, and 30); means for distributing said project request according to type of manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers (paragraphs 34 and 35); and means for facilitating feasibility of manufacture of said project request according to said plurality of feasibility responses (Abstract; paragraphs 45, 46, 48, and 49), in response to receiving feasibility responses at said broker system from said selection of prospective manufacturers (paragraphs 38, 41, 42, and 44).

As per claim 45, Gillman discloses means for transferring said plurality of feasibility responses received from said selection of prospective manufacturers to said buyer (paragraphs 36 and 42).

As per claim 49, Gillman discloses means for controlling access of said plurality of available manufacturers to said plurality of feasibility responses (paragraphs 35 and 47).

As per claim 50, Gillman discloses means for distributing said project request to specific manufacturers designated by said buyer with said project request (paragraph 35).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3-5 and 7-11**

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of Thackston (U.S. Patent 6,295,513). As per claim 3, Gillman discloses selecting a category of manufacturers to invite bids from for said

project request (paragraph 51). Gillman does not expressly disclose selecting a plurality of categories of manufacturers to invite bids from for said project request, but Thackston teaches this (column 42, line 40, through column 43, line 32; column 43, line 61, through column line 13). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select a plurality of categories of manufacturers to invite bids from for said project request, for the obvious advantage of directing project requests to appropriately qualified manufacturers.

As per claim 11, Gillman can be read as disclosing selecting said manufacturer according to at least one rating for said manufacturer (paragraph 49), but, as Gillman may be read as not explicit enough about ratings, Thackston is also noted as teaching ratings of manufacturers (column 42, lines 13-25). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select said manufacturer according to at least one rating for said manufacturer, for the stated advantage of selecting well-qualified manufacturers.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of Ruffo et al. (U.S. Patent Application Publication 2001/0032166). Gillman discloses the buyer providing a URL for the buyer's company's website (paragraph 58); and Ruffo teaches a buyer providing a project specification file stored in a computer system (paragraph 59; see also claim 1). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the step of submitting a specialized project request to comprise the step of providing a project specification file storage location, for the obvious advantage of making the project specification conveniently available to the at least one broker, and to manufacturers.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of Scolnik et al. (U.S. Patent Application Publication 2002/0007333). Gillman does not expressly disclose indicating a level of security for a specialized project request (although the private auction center might be interpreted as doing so; see paragraphs 35 and 47), but Scolnik teaches indicating a level of security for a specialized project request (paragraphs 12 and 28). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to indicate a level of security for the specialized project request, for the obvious advantage of enabling the buyer to determine the desired level of security, and increase his chances of obtaining the desired custom product at a low price, or maintain a project's confidentiality from commercial competitors, foreign spies, etc., as may be appropriate.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of official notice. Gillman does not disclose receiving a suggestion for adjusting said project request to increase manufacturing feasibility, but official notice is taken that it is well known to receive such suggestions. (Examiner recalls receiving

such suggestions when he, as a college or graduate student, took a project proposal to a machinist for custom manufacture.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive a suggestion for adjusting the project request to increase manufacturing feasibility, for the obvious advantage, from the manufacturer's perspective, of being assured of the buyer's consent to proposed modifications, and for the obvious advantage, from the buyer's perspective, of being able to have a desired project manufactured, and of having it manufactured more easily, with concomitant reduced expense.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of the article "Class Action Suit Filed Against StorMedia, Inc. and Its Officers and Directors Alleging Misrepresentations and Insider Trading," hereinafter "Class Action Suit." Gillman does not disclose receiving a project request cancellation due to lack of manufacturing feasibility, but it is well known to cancel a project request due to lack of manufacturing feasibility, as taught by "Class Action Suit" (paragraph beginning "The complaint charges"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the step of receiving a plurality of feasibility responses for a project request to comprise receiving a project request cancellation due to lack of manufacturing feasibility, as an obvious consequence of the inability of some manufacturers, on occasion to manufacture desired products, or their judgment that doing so would not be feasible.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 1 above, and further in view of Posner (U.S. Patent Application Publication 2003/0208434). As per claim 9, Gillman does not disclose submitting an adjusted project request in response to said plurality of feasibility responses, but Posner teaches submitting an adjusted project request in response to at least one feasibility response (paragraphs 54 and 55). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to submit an adjusted project request in response to the plurality of feasibility responses, for the stated advantage of reaching an agreement with a manufacturer.

As per claim 10, Gillman discloses selecting a preferred manufacturer (Abstract; paragraphs 45, 46, 48, and 49), but does not disclose selecting at least one alternative manufacturer. However, Posner teaches selecting at least one alternative manufacturer (paragraphs 47 and 48). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select at least one alternative manufacturer, for such obvious advantages as dividing a project into subprojects, with one manufacturer being best qualified to manufacture one part of a custom product, and another manufacturer best qualified to manufacture another part of the product; or dividing a number of products to be manufactured according to a project request, if, for example, the lowest bidder cannot undertake to manufacture as many items as desired, or to manufacture them as soon as some of them will be needed; or

keeping an alternate manufacturer on standby, in case a preferred manufacturer fails to complete a project to the buyer's satisfaction, or on schedule.

**Claims 13-15 and 17-21**

Claim 13 is essentially parallel to claim 3; claim 14 is essentially parallel to claim 4; claim 15 is essentially parallel to claim 5; claim 17 is essentially parallel to claim 7; claim 18 is essentially parallel to claim 8; claim 19 is essentially parallel to claim 9; claim 20 is essentially parallel to claim 20; and claim 21 is essentially parallel to claim 11. These claims are therefore rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 12 above, and further in view of Thackston, Ruffo, Scolnik, official notice, "Class Action Suit," Posner, Posner, and Thackston, respectively, for the reasons set forth above.

**Claims 22-32**

Claims 22, 23, and 27 are essentially parallel to claims 1, 2, and 6, respectively, and rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) on essentially the same grounds. Gillman refers to programs and software (paragraphs 24, 26, 27, and 29), but does not expressly disclose a program residing on a computer usable medium having computer-readable program code for carrying out the invention as recited in the claims. However, given that Gillman discloses a computer system with programs/software, such a program would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention, for the obvious advantage of enabling the computer system of Gillman's application to function. This could even be called inherent.

Claims 24, 25, 26, 28, 29, 30, 31, and 32 are closely parallel to claims 3, 4, 5, 7, 8, 9, 10, and 11, respectively, and therefore rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman as applied to claim 22 above, and further in view of Thackston, Ruffo, Scolnik, official notice, "Class Action Suit," Posner, Posner, and Thackston, respectively, for the reasons set forth above.

### **Claims 37-39 and 42**

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 33 above, and further in view of Van Horn et al. (U.S. Patent 6,604,089). Gillman does not disclose distributing said project request to a plurality of potential customers (unless prospective manufacturers, etc., qualify as potential customers); receiving customer interest responses from said plurality of potential customers; and distributing said customer interest responses with said project request to said selection of prospective manufacturers in order to provide said selection of prospective manufacturers with an indication of customer interest; but Van Horn teaches distributing a project request to a plurality of potential customers; receiving customer interest responses from said plurality of potential customers; and distributing said customer interest responses to at least one prospective manufacturer in order to provide said at least one manufacturer with an indication of customer interest (column 4, lines 9-21). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention to distribute said project request to a plurality of potential customers; receive customer interest responses from said plurality of potential customers; and distribute said customer interest responses with said project request to said selection of prospective manufacturers in order to provide said selection of prospective manufacturers with an indication of customer interest, for the stated advantage of letting buyers create a market for a particular product, and obtain it more cheaply than would otherwise be possible.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 33 above, and further in view of Posner (U.S. Patent Application Publication 2003/0208434). Gillman does not disclose in response to receiving request adjustment suggestions from said selection of prospective manufacturers, compiling a suggested project request; transferring said suggested project request to said buyer; and in response to receiving an adjusted project request from said buyer, transmitting said adjusted project request to said selection of prospective manufacturers. However, Posner teaches, in response to receiving request adjustment suggestions from at one manufacturer, revising a project request, and transmitting an adjusted project request from a buyer to at least one prospective manufacturer (paragraphs 54 and 55). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive request adjustment suggestions from the selection of prospective manufacturers, compile a suggested project request; transfer the suggested project request to the buyer; and in response to receiving an adjusted project request

the said buyer, transmitting the adjusted project request to the selection of prospective manufacturers, for the stated advantage of reaching an agreement with a manufacturer, and the obvious advantage of arriving at a request for a product which is feasible to manufacture.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 33 above, and further in view of official notice. Gillman does not disclose in response to receiving responses indicating that said project request lacks feasibility, adjusting said project request, but official notice is taken that it is well known to adjust a project request in response to receiving a response indicating that a request lacks feasibility. Gillman discloses polling a selection of manufacturers with a (non-adjusted) project request; and transferring feasibility responses received from the selection of prospective manufacturers to said buyer (paragraphs 26, 27, 30, 38, 41, 42, and 44). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to, in response to receiving responses indicating that a project request lacks feasibility, adjust said project request; poll a selection of manufacturers with the adjusted project request; and transfer feasibility responses received from the selection of prospective manufacturers to said buyer, for the obvious advantage of making project requests feasible to manufacture.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) as applied to claim 33 above, and further in view of official notice. Gillman does not expressly disclose transferring said

project request and said preferred manufacturer to an order procurement system, but discloses notifying a preferred manufacturer of having been selected, after which the buyer and manufacturer "need to consummate the transaction" (paragraphs 48, 49, and 50). Arguably, whatever is done next can be called transfer to an order procurement system; in any event, official notice is taken that it is well known to transfer requests and supplier information to an order procurement system. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer the project request and information regarding the preferred manufacturer to an order procurement system, for the obvious advantage of enabling the buyer to procure the desired product from the preferred manufacturer.

### **Claims 46-48 and 51**

Claims 46, 47, 48, and 51 are closely parallel to claims 37, 38, 39, and 42, respectively, and therefore rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman as applied to claim 52 above, and further in view of Van Horn, Posner, official notice, and official notice, respectively, for the reasons set forth above.

### **Claims 52-53, and 56-61**

Claims 52, 53, 55, 59, and 60 are essentially parallel to claims 33, 34, 36, 40, and 41, respectively, and rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman (U.S. Patent Application Publication 2002/0147674) on essentially the same grounds. Gillman refers to programs and software (paragraphs 24, 26, 27, and 29), but does not expressly disclose a program residing on a computer usable medium having

computer-readable program code for carrying out the invention as recited in the claims. However, given that Gillman discloses a computer system with programs/software, such a program would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling the computer system of Gillman's application to function. This could even be called inherent.

Claims 56, 57, 58, and 61 are closely parallel to claims 37, 38, 39, and 42, respectively, and therefore rejected under 35 U.S.C. 103(a) as being unpatentable over Gillman as applied to claim 52 above, and further in view of Van Horn, Posner, official notice, and official notice, respectively, for the reasons set forth above.

#### ***Allowable Subject Matter***

Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to be clearly within the technological arts.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Gillman (U.S. Patent Application Publication 2002/0147674), anticipates claim 33, as set forth above, but Gillman does not disclose comparing the project request with a plurality of current project requests, etc. The additional features recited in claim 35 are most nearly approached by the demand aggregation system of Van Horn et al. (U.S. Patent 6,604,089) disclose enabling buyers

to submit project requests which other potential buyers are then informed of, for the purpose of obtaining bulk discounts (see especially column 4, lines 1-21, and column 9, lines 55-67). However, neither Gillman, Van Horn, nor any other prior art of record, discloses, teaches, or reasonably suggests comparing a buyer's project request with a plurality of current project requests; notifying the buyer if the project request matches one of said plurality of current project requests; and, in response to receiving a buyer request for said one of said plurality of current project requests, facilitating said buyer in placing a specified order for said one of said plurality of current project requests.

Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 54 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to overcome the objections made for informal claim language.

Claims 44 and 54 are closely parallel to claim 35, and found to be potentially allowable on the same grounds.

### ***Regarding IDS***

On the Information Disclosure Statement dated June 7, 2001, one of the listed documents is "AUS920010357, Brokering and Facilitating Consumer Projects in an E-Commerce System." This refers to the instant application, and is therefore believed to

be an error. Presumably, Applicant wished Examiner to consider related application "AUS920010356US1, Managing Customization of Projects Prior to Manufacture in an Electronic Commerce System," serial number 09/876,057. Examiner wishes to make of record that he has considered this related application.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Esfandiari et al. (U.S. Patent 6,687,682) disclose a system for discounting in a bidding process based on quality of service.

Lee et al. (U.S. Patent Application Publication 2002/0065762) disclose a method and visual interface for evaluating multi-attribute bids in a network environment. Brewer et al. (U.S. Patent Application Publication 2002/0156857) disclose a method and system for posting requests for bids for professional services. Lee et al. (U.S. Patent Application Publication 2002/0165814) disclose a system and method for ranking objects having multiple attributes. Gilbert et al. (U.S. Patent Application Publication 2003/0033239) disclose requests for quote and inside markets. Scott et al. (U.S. Patent Application Publication 2004/0073507) disclose a method and system for providing international procurement, such as via an electronic reverse auction.

Groult et al. (WO 00/54204) disclose an Internet-based exchange for products and services (made of record by Applicant, listed on IDS).

The anonymous article "Bolivar: Comibol Goes It Alone," discloses canceling a bid. Derfler ("Smart Business Buying") discloses websites and systems for business

procurement. The anonymous article, "Awash with Benefits," discloses ordering customized products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**PRIMARY EXAMINER**  
August 30, 2004